



BUCKET NO. 01-MV-0111 (STMI01-01111)
CUSTOMER NO.: 30425

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of : REN EGAWA, ET AL.
Serial No. : 10/034,751
Filed : December 27, 2001
For : APPARATUS AND METHOD FOR TRANSCODING
STILL IMAGE DATA FILES INTO MPEG VIDEO DATA
FILES AND DIGITAL VIDEO PLAYER IMPLEMENTING
SAME
Group No. : 2621
Examiner : Daniel T. Tekle

MAIL STOP AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal. The review is requested for the reason(s) stated in the arguments below, demonstrating the clear legal and factual deficiency of the rejections of some or all claims.

Claims 1-8, 10-17 and 19-20 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,151,074 to *Werner*, hereinafter “Werner”. For the convenience of the panel, claim 1 is reproduced:

1. (Original) For use in a digital video player, an apparatus for displaying a digital still image file using a Moving Picture Expert Group (MPEG) standard, the apparatus comprising:

a controller capable of dividing the digital still image file into a plurality of sub-picture files, the controller further capable of constructing an MPEG video stream from the plurality of sub-picture files; and

an MPEG processor capable of decoding the MPEG video stream to generate a plurality of decoded sub-pictures and scaling down the plurality of decoded sub-pictures to a plurality of reduced size decoded sub-pictures.

Claim 1 requires, among other limitations, “a controller capable of dividing the digital still image file into a plurality of sub-picture files, the controller further capable of constructing an MPEG video stream from the plurality of sub-picture files” (emphasis added). This feature is not taught or suggested at all by Werner. Werner does mention in col. 5 that it “can be” for still or full-motion decompression algorithms, but does not then teach anything concerning a still image decompression algorithm.

Specifically, at no point does Werner teach or suggest anything related to dividing a still image file into a plurality of sub-picture files. In fact, Werner doesn’t teach anything about files at all. Examiner Tekle responds that “Werner does teach, ‘Decoding engine processor programmed to decompress video data. Also Werner teaches various compression standards include JPEG and MPEG program to decompress still or motion algorithms (column 5 lines 27-58).’” For convenient reference, this passage reads:

Decoding engine 24 is a processor programmed to decompress the video data. It may be programmed to support various compression standards, such as the JPEG, MPEG, MPEG2, Px64, CCITT, etc. The programming can be for either still or full-motion decompression algorithms. Decoding engine 24 could be a multi-format decoding engine, switchable between decompression algorithms to perform whatever decompression method is appropriate for the input signal. The output of decoding engine 24 is decompressed pixel data which, in the example of this description, is in YCbCr format.

An example of a suitable decoding engine 24 is the decoding engine of the CL450 MPEG Video Decoder manufactured by C-Cube Microsystems. It provides decompressed YCrCb data with an image size consistent with the input signal.

A decoding engine bus 22b carries control information and data between decoding engine 24 and memory manager 22. The control information includes requests for data from decoding engine 24, which requests data as needed for processing. In response to a request, memory manager 22 generates the address of the next data to be decoded, retrieves the data from memory 23, and delivers it to decoding engine 24. Bus 22b is bidirectional--after decompression, decoding engine 24 delivers the data back to memory manager 22, which generates an address for storing it in memory 23.

It is clear that nothing in this passage teaches or suggests anything related to dividing a still image file into a plurality of sub-picture files, or anything at all about files.

The Examiner further responds (entire quotation *sic*):

It is inherent JPEG or MPEG decoder to divide digital still image in to plurality Macroblock or block and reconstruct to a picture frame. There is no difference between constructing an MPEG video from the plurality of sub-picture and constructing an MPEG video from plurality of Macroblock since sub-picture made of plurality blocks.

Nothing at all in Werner teaches or suggests dividing a digital still image file into a plurality of sub-picture files, as claimed. This is not "inherent" to anything Werner teaches, nor to any part of

the JPEG or MPEG standard. Nothing in the art of record even teaches that the claimed "dividing a digital still image file into a plurality of sub-picture files" may even happen. This is a legally deficient rejection.

The Examiner further states that "Also MPEG video is made of a plurality image file or frames." While an MPEG video, when played, displays a series of frames, it is factually incorrect to say that MPEG video is "made of a plurality image file," to the extent the Applicant understands this statement. This is a factually deficient rejection.

Examiner Tenke responds, without providing any basis at all:

It is (inherent) necessary MPEP encoder divides digital still image into plurality Macro block or block in order to encode video signal, the frame of the video must be divided into block or Macroblocks. The Macroblock or block anticipates the claimed sub-pictures file. It is necessary to divide the video frames into sub-pictures files in MPEG encoding.

Examiner Tenke provides no basis in fact or any technical reasoning or other support, as required, although he does underline "necessary": "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

A "macroblock" is commonly known to be a block of pixels in a picture, and has nothing to do with files at all. Nothing in Werner, or any other art of record, alone or in combination, teaches or suggests a controller capable of dividing a digital still image file into a plurality of sub-picture files, as claimed. Nothing in Werner, or any other art of record, alone or in combination, teaches or

suggests a controller capable of constructing an MPEG video stream from the plurality of sub-picture files, as claimed. Independent claims 11 and 18 includes similar language. As a result, the rejection is legally and factually deficient for all claims.

CONCLUSION

As a result of the foregoing, the Applicant asserts that the claims in the Application are in condition for allowance over all art of record, and that the rejections are both factually and legally deficient, and respectfully requests this case be returned to the Examiner for allowance or, alternatively, further examination.

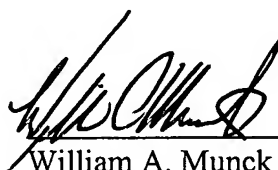
The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Munck Butrus Deposit Account No. 50-0208.

Respectfully submitted,

MUNCK BUTRUS, P.C.

Date:

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